

Application No. 09/724,315
Amendment dated September 21, 2004
Response to Office Action mailed April 26, 2004

REMARKS/ARGUMENTS

After entry of this amendment, claims 56-58, 61, 63-66, 68, 69, 71-79, 81, 83, 85, 86, 89, 92-94, 97, 99, 101-209 are pending. Claims 56-58, 61, 63-66, 68, 69, 71-79, 81, 85, 86, 89, 92-94, 97, 99, 164-201 are under consideration, claims 1-55, 59, 60, 62, 67, 70, 80 82, 84, 87, 88, 90, 91, 95, 96, 98 and 100 having been canceled, claims 83 and 101-163 having been withdrawn, and new claims 164-209 having been added. Claims 56-58, 97 and 99 have been amended. No amendment should be construed as an acquiescence in any ground of rejection.

Claim 56 was previously directed to preventive and treatment methods. The subject matter has now been divided into two independent claims. Claim 56 is directed to methods of treatment, and new claim 183 to methods of prophylaxis (the term "preventing" has been replaced with prophylaxis as in other related cases). Support for prophylaxis is provided at e.g., p. 27, lines 12-14. New claims 183-185; 186; 188-191; 192-193; 194-202; 203; 204-205; 206; 207-209 correspond in part to previously presented claims 56-58; 61; 63-66; 68-69; 71-79; 81; 85-86; 89; 92-94. Claim 56 has also been amended to recite chimeric or humanized antibodies. Support for this amendment is provided at, e.g., page 2, line 30 of the specification. Thus, the amendment contains no new matter.

Claim 97 has been amended to recite a pharmaceutical composition comprising a chimeric or humanized antibody which specifically binds to an epitope within residues 13-28 of A β and a pharmaceutical carrier. Support for a pharmaceutical composition comprising chimeric or humanized antibodies is provided at, e.g., page 2, line 30 of the specification. Support for a pharmaceutical carrier is provided at, e.g., page 31, lines 22-25 of the specification. Thus, the amendment contains no new matter.

New claims 164-182 depend from claim 97. Support for new claim 164 is provided at, e.g., page 28, lines 20-21. Support for new claims 165-168 is provided at, e.g., page 31, lines 22-28. Support for new claims 169 and 170 is provided at, e.g., page 31, line 33 to page 31, line 4. Support for new claims 171-181 is provided at, e.g., page 32, lines 5-13. Support for new claims 182-184 is provided at, e.g., page 32, lines 18-20. Thus, new claims 164-182 contains no new matter.

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Specification

The specification has been amended to delete the embedded hyperlink. Thus, mooting the rejection.

Drawings

The Examiner has objected to the drawings because Figs. 15A-15E are not mentioned in the description. The specification has been amended to include reference to Figs 15A-15E. Thus, mooting the rejection.

Provisional Non-Statutory Double Patenting

Claims 56-82, 85, 86, 89, 92-94, 97, and 99 are provisionally rejected for same invention double patenting over claims 1-30 of U.S. Application No. 09/580,015 and claims 1-47, 135, 144, and 145 of U.S. Application No. 09/979,701. Applicants propose the issues be held in abeyance until indication of allowability in the present case. Applicant will then consider providing a terminal disclaimer over cited cases provided the cited case has been or is about to be patented, the claims in the cited cases have not been divided from those in the present case by restriction requirement or election of species, and the claims in the cited case are in conflict with those in the present case at this time.

Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 56-82, 85, 86, 89, and 92-94 are rejected under 35 U.S.C. § 112, first paragraph. The Examiner says the above claims are enabled for treating Alzheimer's disease via administration of an antibody that specifically binds to an epitope within residues 13-28 of A β . However, the Examiner alleges the claims are not enabled for preventing Alzheimer's disease, preventing or treating Down's syndrome or administration of an antibody that binds other components of an amyloid deposit. The claims have been amended to recite prophylactically or therapeutically treating Alzheimer's disease to expedite prosecution without conceding that the Examiner's rejection is warranted on this basis.

Claims 57-58 and 99 are rejected under 35 U.S.C. § 112, first paragraph. The Examiner alleges the above claims are not enabled for the 266 antibody. Applicant deposited the cell line producing the antibody 266 with the ATCC on July 20, 2004. Applicant submit a statement under MPEP § 2406.02 herewith. Applicant has amended the paragraph beginning on p. 70, line 13 of the specification to recite the depository, accession number, and deposit date of

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the cell line producing the 266 antibody. Claims 57, 58 and 99 have been amended to recite the ATTC accession number for the 266 antibody. These amendments do not add new matter (see *In re Lundak*, 227 USPQ 90 (Fed. Cir. 1985) and MPEP § 2406.01).

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



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